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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,489	03/08/2001	Isao Iwaguchi	1081.1111/JDH	2199
21171	7590	08/25/2008		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER KUCAB, JAMIE R	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 08/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/800,489

**Applicant(s)**

IWAGUCHI ET AL.

**Examiner**

JAMIE KUCAB

**Art Unit**

3621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22, 23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22, 23, 25, 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Acknowledgements*

1. Applicant's response filed May 27, 2008 is acknowledged.
2. Claims 22, 23, 25, and 26 are pending in the application.
3. This Office action is given Paper No. 20080819 for reference purposes only.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 22, 23, 25, and 26, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Swartz et al. (U.S. 2003/013298 A1 hereinafter "Swartz").
6. Regarding claims 25 and 26, Swartz discloses a goods purchase information processing system (Fig. 1-3, 6) in a store (site 10), comprising:
  - a mobile terminal (portable terminals 12E or 12F in Fig. 1, 70 in Fig. 3) having
    - a first communication unit (radio 702),

- a controller (CPU 701) and
    - a memory (memory 712) and
    - being held by a user (the portable terminals can be PDAs, ¶47);
  - a reader (kiosk 19, scanning companion 21B, or terminal 21A) reading goods information for goods purchased by said user of said mobile terminal; and
  - a register terminal comprises:
    - a second communication unit (access point 13B) for communicating with said mobile terminal;
    - a third communication unit for communicating with said reader (access point 13A); and
    - a controller (central host 14) connected to said second and third communication units and calculating goods settlement information from said read goods information through said third communication unit and processing the settlement in response to a prompt from a settlement key in accordance with authorization of said user, wherein said controller sends said goods settlement information to said mobile terminal in response to a prompt from the settlement key of said goods settlement information through said second communication unit, and the mobile terminal temporarily stores the goods purchase information in said memory (¶242).
7. Regarding claims 22 and 23, Swartz further discloses wherein said mobile terminal transfers the goods purchase information (bookmark concerning an item of

interest or customer's prior purchase records) from the memory into a household budget system (shopping list system) of said processing device (home computer 45) of said user (§62, §64, §175, §212).

***Examiner Note***

8. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Claim Interpretation***

9. Independent claims (claims 25 and 26) are examined together, since they are not patentably distinct. If Applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the Applicant to elect an invention to which the claims will be restricted.

10. Unless expressly noted otherwise, the Examiner maintains the claim interpretations and definitions put forth in the previous Office actions, especially §§ 8 and 9 of the Office action, Paper No. 20070503, mailed May 21, 2007.

***Response to Arguments***

11. Applicant's arguments with respect to the § 101 2<sup>nd</sup> ¶ rejections of claims 22-26 have been fully considered and are persuasive. The § 101 2<sup>nd</sup> ¶ rejections of claims 22-26 of the previous Office action have been withdrawn.
12. Applicant's arguments with respect to the § 112 2<sup>nd</sup> ¶ rejections of claims 22-26 have been fully considered and are persuasive. The § 112 2<sup>nd</sup> ¶ rejections of claims 22-26 of the previous Office action have been withdrawn.
13. Applicant's arguments with respect to the 102 rejections of claims 22-26 have been fully considered but they are not persuasive.
14. Applicant argues that Swartz fails to disclose a "second communication unit" communicating with a "mobile terminal" and a "third communication unit" communicating with a "reader". However, the recitation which Applicant argues is not positively claimed (see ¶9 of the Office action, Paper No. 20070503, mailed May 21, 2007), therefore, the elements mapped to these communication units must only contain structural elements as required to meet the functional limitations. That is, the communications units (access point 13a and access point 13b) must have the hardware required to be capable of communicating with another device. As Applicant admits on page 6, lines 4-7 of the remarks filed May 27, 2008, these access points communicate with another device (and must have the hardware required to do so), therefore, these access points read on Applicant's claimed communication units.
15. Applicant argues that Swartz fails to disclose the second controller "calculating goods settlement information from said read goods information," "processing the

settlement in response to a prompt from a settlement key," and "sending said goods settlement information to said mobile terminal." However, Swartz discloses the second controller "calculating goods settlement information from said read goods information" and "processing the settlement in response to a prompt from a settlement key" at ¶242. Swartz further discloses "sending said goods settlement information to said mobile terminal" at ¶227.

### ***Conclusion***

16. This action is made final. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

17. A shortened statutory period for reply to this final action is set to expire three months from the mailing date of this action. In the event a first reply is filed within two months of the mailing date of this final action and the advisory action is not mailed until after the end of the three-month shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than six months from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

19. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621